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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,076	10/16/2003	Joseph Henry	TXT-003	9086
51414	7590	06/01/2005	EXAMINER	
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			SELLS, JAMES D	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/687,076

**Applicant(s)**

HENRY, JOSEPH

**Examiner**

James Sells

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6-14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 8, 10, 12-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sowards (US Patent 4,505,780) in view of Benzing, II (US Patent 6,592,704).

Sowards discloses a system for joining weatherstrippings. As shown in Fig. 1, the apparatus comprises base 10 with weatherstripping holders or tracks 13 and 14, which are slidable in the base 10. Heated knives or blades 17 are coupled to the base for cutting the weatherstrippings. Ultrasonic horn welds two abutting strips of weatherstripping.

The applicant is reminded that the materials used (i.e. weatherstripping comprising a sealing element and a backing element) are not germane to the patentability of an apparatus claim.

However, Sowards does not disclose the blade for longitudinal shaving as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Benzing.

Benzing discloses a method and apparatus for forming splice ends for elastomeric strips. As shown in Figs. 5a-d, the apparatus comprises cutting element

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120 which cuts strip 1 with skive surface 6 (see col. 9, line 16 through col. 10, line 5). At col. 9, lines 27-30, Benzing specifically discloses that the skive surface is inclined generally less than 30° and preferably about 10° or less. Thus, cutting element 120 shaves the strip in the manner claimed by the applicant. As shown in Figs. 8a-b, opposed skive surfaces 6 are brought together and pressed to form a splice (see col. 8, lines 13-16).

Benzing discloses that this method and apparatus provides the precision of butt splicing while also having the superior surface adhesion are found in lap type splices (see col. 8, lines 30-34). For these reasons, it would have been obvious to one having ordinary skill in the art to employ a cutting element to shave or form skive surfaces, as taught by Benzing, in the system of Swards as described above.

Regarding claim 10, it is the examiner's position that the weatherstripping positioned in the tracks 13 and 14 of Swards are capable of sliding in the tracks. Since applicant has not claimed means for sliding the weatherstripping pieces, but has merely claimed that the pieces slide along the channel, the examiner believes the disclosure of Swards teaches this aspect of applicant's claim.

Regarding claims 16-19, as stated above, Benzing specifically discloses that the skive surface is inclined generally less than 30° and preferably about 10° or less. It is the examiner's position that such a range of angles suggests that various angles may be employed. Therefore it is the examiner's position that the amount shaved (i.e. substantially the entire thickness of the sealing element) and the manner of cutting (i.e. shaving a variable predetermined thickness and the blade travels substantially parallel

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to the weatherstripping) are within the purview of one having ordinary skill in the art and would have been obvious to employ in the apparatus of Swards in view of Benzing based upon the physical requirements of the materials being spliced.

3. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swards in view of Benzing, II as described above in paragraph 2 in further view of Kanda et al (US Patent 5,123,992).

However, Swards and Benzing do not disclose the stop or the handle as claimed by the applicant. Regarding these differences, the applicant is directed to the reference of Kanda.

Kanda discloses a tape splicer. As shown in Figs. 1-3, the apparatus comprises base 1 with groove or track 19 for receiving recording tape. Pins 19 function as applicant's claimed stop. Cutter 26 includes stationary blade 27 and movable pivoting or rotating blades 28 and 29. Knobs 33 and 34 function as applicant's claimed handle.

It would have been obvious to one having ordinary skill in the art to employ a stop and a handle, as taught by Kanda, in the apparatus of Swards in view of Benzing in order to facilitate splicing of the materials.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swards in view of Benzing, II as described above in paragraph 2 in further view of Becking (US Patent 5,304,266).

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However, Sowards and Benzing do not disclose the clamps as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Becking.

Becking discloses a ribbon welding system. As shown in Figs. 1-3, ends 114 and 116 of ribbon 112 are positioned in channels defined by guide plate 186 and clamped by ribbon clamp assemblies 154a and 154b of welder 100. Cutter assembly 152 cuts the ribbons and ultrasonic welding horn presses and 180 welds the ribbon ends together.

It would have been obvious to one having ordinary skill in the art to employ clamps, as taught by Becking, in the apparatus of Sowards in view of Benzing in order to more precisely position the materials before splicing them together.

***Allowable Subject Matter***

5. Claims 1-5 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, in a method of splicing weatherstripping including a sealing element and a backing element, the prior art does not teach or make obvious the concept of the combination steps comprising cutting a portion of the sealing element from a first piece of weatherstripping, leaving an exposed portion of the backing element, overlapping the exposed portion of the backing element with a backing

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element of a second piece of weatherstripping and ultrasonically joining the exposed portion of the backing element of the first piece of weatherstripping to the backing element of the second piece of weatherstripping in the manner claimed by the applicant.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-14 and 16-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Telephone/Fax***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday between 9:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

A handwritten signature in black ink, appearing to read 'JS', with a horizontal line drawn underneath it.

**JAMES SELLS  
PRIMARY EXAMINER  
TECH. CENTER 1700**